

REMARKS

This is a response to the Examiner's Answer dated May 4, 2006 in connection with the appeal of the above-identified application.

Initially, appellant would like to point out that there is no rejection of the claims under 35 U.S.C. § 112.

The Examiner relies on two references, Ceniz U.S. Patent 3,981,604 and Ball et al. U.S. Publication 20030163151. The Examiner takes the position that both of these references include isolated structural elements similar to those claimed in the body of the claims at issue. For example, the Examiner considers that if the press fit bushing 21 of Ceniz were pulled out of plate 14 it could be used in some sort of fixture to receive some sort of reamer with its outer surface rotatably received within the fixture with apparently the correct number of flutes required for the presumed claimed bone reamer. The Examiner is giving no patentable weight to either the functional language of appellant's claims nor the statement of intended use in the preamble or apparently any other limitations in the preamble. The Examiner has merely found a structural element similar to that claimed and ignored how that element functions in the entire structure of the cited reference.

Furthermore in column 3, lines 41-45 of Ceniz make it clear that the number of scraper recesses 22 are not critical. The Examiner considers claim 14 as being anticipated by Ceniz or Ball et al. even though claim 14 sets forth specific limitations for the number of flutes and recesses.

The Examiner gives no patentable weight to the limitation of the outer bearing surface of the bushing rotatably engaging the surface of the fixture in which the bushing is mounted. The Examiner apparently considers the function of rotatably engaging the surface of a fixture to be of no patentable significance. It is noted that neither Ceniz nor

Ball et al. disclose any fixture for rotatably receiving their "bearing" outer surface.

The Examiner's answer is replete with statements that the prior art has to only be capable of being used in the same ways that are claimed by Applicant. At the bottom of page 11 the Examiner states that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation. Appellant wishes to point out that the term "capable of" is not used in any of the claims under appeal. Appellant also wishes to point out that if the bushing of Cenis were not press fit or glued then the bushing would not function for its intended purpose of scraping material off the pin 15. Appellant believes it is incorrect for the Examiner to pick and choose from a reference structural elements while ignoring the teaching of the reference as a whole.

The Examiner is incorrect in her contention that functional limitations can't be used to distinguish over prior art. A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart* 439 F.2d 210, 169 USPQ 226 (CCPA 1971). The Examiner cannot merely disregard all functional language (see MPEP 2173.05(g)).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person or ordinary skill in the pertinent art in the context in which it is used.

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions...being resiliently dilatable whereby said housing may

be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

The Examiner then states that any limitations in the preamble such as statements for intended use are not limitations of the claim. Again, appellant does not believe this is a correct interpretation of the law.

The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is not litmus test defining when a preamble limits the scope of a claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). See *id.* at 800-10, 62 USPQ2d at 1784-86 for a discussion of guideposts that have emerged from various decisions exploring the preamble's effect on claim scope, as well as a hypothetical example illustrating these principles.

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966.

However, a "preamble may provide context for claim construction, particularly where that preamble's statement of intended use forms the basis for distinguishing the prior art in the patent's prosecution history." *Metabolite Labs, Inc. v. Corp. of Am. Holdings*, 370 F.3d 1354 1358-62, 71 USPQ2d 1081, 1084-87 (Fed. Cir. 2004).

See also *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d at 808-09, 72 USPQ2d at 1785 ("[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. Without such reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claim invention."

It is apparently the Examiner's position that if appellant were to claim "A bone reaming system comprising" followed verbatim by the present claim 12 language then the limitations would be contained in the body of this claim rather than in the preamble. Appellant believes that it is abundantly clear that the preamble forms a limitation of claim 12.

It is appellant's position that the Examiner is not reasonably interpreting the claims and the prior art as would one of ordinary skill in the orthopedic instrument art. For example, no one in the orthopedic art would consider the knurled surface 23 of Ball et al. to be a rotatable bushing surface nor threads 23. If somehow threads 23 of Ball et al. were screwed into a fixture the structure of Ball et al. could not function as a reamer bushing which is clearly intended by the claim language. A reamer is a rotating finishing tool with cutting edges used to enlarge or shape a hole. Thus a reamer bushing must rotate at a high speed over an extended period of time which would not be possible with the threaded connection of FIG. 4 of Ball et al. Consequently, Applicant respectfully disagrees with the positions taken by the Examiner and requests that the claims be passed on to allowance.

Application No.: 10/679,569

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If there are any additional charges in connection with this response, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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